REMARKS

Claims 1-52 are all the claims presently pending in the application.

It is noted that Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 5-13 and 31-39 are allowed. Applicant gratefully acknowledges that claims 3, 15, 26, 29, 41, and 52 would be allowable if rewritten in independent form. However, Applicant believes that all of the claims are allowable.

Claims 1, 2, 4, 14, 16-25, 27-28, 30, 40, and 42-51 stand rejected under 35 U.S.C. § 103(a) as unpatentable over US Patent 6,510,156 to Brock et al., further in view of "Generic Framing Procedure (GFP) Specification", October 9-13, 2000, by Hernandez-Valencia (Ed.).

This rejection is respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention is directed to a GFP frame transfer apparatus for transferring a GFP (Generic Frame Procedure) frame over a GFP network. An FCS generation section generates, when the GFP frame is generated and sent by the GFP frame transfer apparatus, an FCS (Frame Check Sequence) using the payload field, without the payload header, of the GFP frame as the generation target area and adds this FCS to the FCS field of the GFP frame.

As explained beginning at line 13 on page 6, conventional methods update the payload header and recalculate the FCS. Although it is possible to perform monitoring in ring units using the FCS field, it is not possible to perform monitoring of the end-to-end path from the SONET node of Ingress to the SONET node of Egress.

The claimed invention, on the other hand, provides a method for performance monitoring of an end-to-end path using the FCS field of a GFP frame. It achieves this capability by generating an FCS using the payload of the GFP frame as the generation target area and adding this to the FCS field of the GFP frame.

II. THE PRIOR ART REJECTION

The Examiner alleges that Brock, further in view of Hernandez-Valencia, renders obvious the claimed invention as defined by claims 1, 2, 4, 14, 16-25, 27-28, 30, 40, and 42-

51. Applicant submits, however, that there are elements of the claimed invention which are neither taught nor suggested by Brock, even if modified by Hernandez-Valencia.

Relative to primary reference Brock, Applicants submit that this reference address ATM, not GFP, which the Examiner concedes. However, Applicants submit that Brock, with the possible exception of the selectively handling the payload without the header, also fails to satisfy the plain meaning of the claim language in the independent claims. Therefore, Applicants submit that the rejection currently of record fails to meet the initial burden of a *prima facie* rejection.

That is, in the rejection currently of record, there is no citation to column and line number in Brock relative to the generation of an FCS (Frame Check Sequence) using the payload field without the payload header and adds this FCS to the FCS field.

This feature of the present invention allows it to perform monitoring in ring units using the FCS field as a solution to the problem in the art that it is not possible to perform monitoring of the end-to-end path from the SONET node of Ingress to the SONET node of Egress.

Moreover, the description at lines 17-60 of column 4 of primary reference Brock clearly indicates that the separation of the payload field from its header occurs only if there is redundancy with a previous cell. In contrast, the present invention is not based upon and is not articulated as being a selective detachment of these fields.

Hence, turning to the clear language of the claims, in Brock, even if modified by secondary reference Hernandez-Valencia, there is no teaching or suggestion of " ... comprising an FCS generation section that generates, when said GFP frame is generated and sent by said GFP frame transfer apparatus, an FCS (Frame Check Sequence) using a payload field, without a payload header, of said GFP frame as a generation target area and adds this FCS to an FCS field of said GFP frame", as required by independent claim 1. Rejected independent claim 27 has similar language.

Applicants also respectfully submit that the rejection currently of record fails to provide a reasonable motivation to modify the primary reference. The rejection currently of record simply attempts to substitute the GFP frame of the secondary reference into the ATM frame of the primary reference. Applicants submit that such substitution would be improper hindsight, since such substitution would clearly change the principle of operation of the primary reference Brock, and would be impermissible hindsight, as explained in MPEP §2143.01: "*If the proposed modification or combination of the prior art would change the*

principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie *obvious*", describing the holding of *In Re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA, 1959), and

"*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination*" (emphasis MPEP itself), describing the holding of *In re Mills*, 916 F.2d 680, 16 USPQ 2de 1430 (Fed. Cir. 1990).

In the rejection, the Examiner suggests that one having ordinary skill in the art would have been motivated to modify primary reference Brock is that such modification would allegedly provide "... *more efficiency for the system since the system uses a standard format for transferring [the] frame over the network and the added feature of using a SONET ring network.*" Applicants submit that this motivation is clearly impermissible hindsight, since the primary reference does not require these features, would not benefit from these features, and would experience no improvement in efficiency for the system described in Brock.

Indeed, because of the added calculation needed to accommodate the generic GFP format, Applicants submit that the efficiency of Brock would actually decrease.

Moreover, Applicants submit that this motivation for modification simply engages in selectively re-designing the purpose and principle of operation of Brock to accommodate the present invention. The Examiner points to no suggestion in either reference to make such fundamental changes to Brock, and the rationale for the modification is simply a circular argument wherein the reason for modification is that one would obtain the result of having made the modification.

It is further noted that the only portion of independent claim 1 that is reasonably satisfied in Brock, as described in detail above, is that of selectively separating the payload header from the payload field. There is no suggestion of using this payload field alone in a calculation of FCS or of adding the recalculated FCS to the FCS of the GFP frame. That is, there is only one limitation of the independent claim that is reasonably satisfied in the primary reference. None of the remaining definition of the invention in the independent claim is present in the primary reference. Therefore, it is clear that the principle of operation of primary reference would have to be changed fundamentally in order to satisfy the claim language of independent claims 1 and 27.

Applicants submit that such pervasive change of the independent claims also clearly indicates that the evaluation currently of record fails to honor the "as a whole" analysis

described in MPEP §2141.02: "*In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious*", *Stratoflex, Inc., v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir., 1983).

Moreover, even if the primary reference were to be modified, the basic deficiency identified above for the primary reference would still not be overcome.

Therefore, Applicants submit that there are elements of the claimed invention that are not taught or suggest by Brock, even if modified by Hernandez-Valencia, and the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-52, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 2/22/07

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